

## **REMARKS**

### **STATUS OF CLAIMS**

Claims 1-39 are pending in this application, claims 1, 27 and 33 being the independent claims. Claims 22-37 have been withdrawn due to a restriction requirement by the Examiner, and claims 9-13 and 38-39 are hereby cancelled. Therefore, claims 1-8 and 14-21 are currently under examination. Applicant hereby amends independent claim 1. Support for the amendments to claim 1 are found in the application as filed, *inter alia*, paragraph [0031] of the specification and original claim 13. There is no issue of new matter.

### **Rejection under 35 U.S.C. 103(a)**

Claims 1-6, 11-12, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon et al. (U.S. Pat. Appln. Pub. No. 2003/0092689).

Claims 9-10, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon in view of Ramstack et al. (U.S. Pat. 6,667,061).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon in view of Ramstack et al. (U.S. Pat. 6,667,061), in further view of Lund (U.S. Pat. 3,869,546).

Claims 14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon in view of Glajch (U.S. Pat. 5,147,631).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon in view of Glajch and Lauffer (U.S. Pat. 7,175,829).

Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escandon in view of Cochrum, (U.S. Pat. 5,614,204). In response, Applicants respectfully traverse the above rejection and its accompanying remarks and states that the rejection has been rendered moot by the cancelling of claims 38-39.

In response, Applicants respectfully traverse the above rejections and their accompanying remarks and states that the rejections have been rendered moot by the amendments to independent claim 1, wherein the claim is directed to an injectable formulation comprising (a) a chemical ablation agent in an amount effective to cause tissue necrosis, and (b) a biodisintegrable viscosity adjusting agent comprising polyalkylene oxide polymers comprising polyethylene

oxide, polypropylene oxide, poly(ethylene oxide-propylene oxide), or polyoxyethylene (polyethylene glycol). There is simply no teaching or suggestion within the four corners of the cited prior art references for the composition of amended claim 1, wherein the viscosity adjusting agent comprises a polyalkylene oxide polymer.

The asserted prior art must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). As the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). In the present instance, Applicant asserts that the cited prior art fail to teach all of the features of the claimed invention. Specifically, the combination of Escandon, Ramstack, Lund, Glajch, Lauffer and/or Cochrum fails to teach or suggest the claim features introduced by this amendment. For at least these reasons, Applicant states that the amendments obviate the rejections and render the claims patentable over the cited references. Reconsideration and withdrawal of the rejection is thereby kindly requested.

**CONCLUSION**

Applicant submits that Claims 1-8 and 14-21 are in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicant's attorney at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,

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